

REMARKS

I. Introduction

Applicant adds new claims 24-47.¹ Therefore, by this Amendment, claims 1-47 are pending in the application. Claims 1-23 have been examined² and are rejected. Specifically, the Examiner presents the following new grounds of rejection for claims 1-23.

Claims 1-3, 5-13 and 15-23 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,754,636 to Bayless et al. (hereinafter “Bayless”). Claims 4 and 14 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bayless in view of newly applied U.S. Patent No. 5,588,049 to Detering et al. (hereinafter “Detering”).

Additionally, claim 17 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

By way of overview, Applicant overcomes the rejections of claims 1-23 as follows.

II. Claim Rejections – 35 U.S.C. § 112, Second Paragraph

Claim 17 stands rejected under § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

¹ An Excess Claim Fee of \$1200.00 is enclosed.

² The appeal of claims 1-23 has been withdrawn by the Examiner, such that the prosecution of claims 1-23 is reopened.

the invention (Office Action: page 2). Applicant amends claim 17 to correct the antecedent basis issue identified by the Examiner, thereby overcoming the rejection.

III. Claim Rejections – 35 U.S.C. § 102(e)

Claims 1-3, 5-13 and 15-23 stand rejected under § 102(e) as allegedly being anticipated by Bayless.

A. Claims 1-3, 10, 12 and 22

As an initial matter, Applicant amends claim 1 to further clarify that a first operation is performed to select a string of character information in a displayed window and store the selected string. Furthermore, in claim 1, a second operation is performed to extract a telephone number from the stored string and to dial a call based on the extracted telephone number.

Claim 1 is directed to a telephone call dialing method. The Examiner, however, relies on an unrelated phone directory importing feature of Bayless in alleging that claim 1 is anticipated. Applicant respectfully disagrees.

In Bayless, an import map window 358 facilitates the importing of phone directories, which were previously created for other applications, by a user (Bayless: col. 23, lines 56-63; and col. 24, lines 33-35). Because the values to be imported are displayed in the import map window 358, the user can view the actual data to be imported, allowing easy creation of a mapping in database map window 360 (Bayless: col. 24, lines 34-37).

By viewing the data of a record to be imported in import map window 358, the user can see what each position in the imported records represents (Bayless: col. 24, lines 15-17; and Fig.

31). For example, in Fig. 31 of Bayless, the user can look at the values displayed in import map window 358 and determine that the values for position 4 represent a name suffix. Accordingly, Bayless allows the user to drag from position 4 of the import map window 358 and to drop on name suffix directory field in database map window 360. In this manner, a user can assign a position for each imported field (of the imported records) to particular directory fields (Bayless: col. 24, lines 19-22). When the user has finished designating the mapping in the database map window 360, the user can save the mapping to a file and perform the importation using the saved mapping (Bayless: col. 24, lines 28-31).

Thus, in Bayless, a user must perform operations including determining the positions for the data to be imported, assigning the positions for each imported field, saving the mapping to a file and importing the data using the mapping. Furthermore, still more operations may be necessary to, for example, import a type of data from an application that did not support inclusion of such a data type (Bayless: col. 24, lines 33-50). Additionally, each of these operations merely relate to importing a phone directory and not to dialing a call.

In view of the above, it is respectfully submitted that Bayless fails to disclose or suggest a telephone call dialing method including performing a first operation to select a string of character information in a displayed window and store the selected string, and performing a second operation to extract a telephone number from the stored string and to dial a call based on the extracted telephone number. Therefore, claim 1 is not anticipated by Bayless.

Claim 10 is directed to an information terminal. Claim 22 is directed to a computer-readable recording medium. Claims 10 and 22 recite features similar to claim 1. Therefore, claims 10 and 22 are not anticipated by Bayless based on a rationale analogous to that set forth above for claim 1. Consequently, claims 2-3 and 12 are not anticipated by Bayless at least by virtue of their dependency.

B. Claims 5-9 and 23

As an initial matter, Applicant amends claim 5 to further clarify that a first operation is performed to select a string of character information in a displayed second window and store the selected string. Furthermore, in claim 5, a second operation is performed to extract a telephone number from the stored string and to display the extracted telephone number in a first window. Further still, a third operation is performed to dial a call based on the extracted telephone number.

Based on a rationale analogous to that set forth above for claim 1, it is respectfully submitted that Bayless fails to disclose or suggest a telephone call dialing method including performing a first operation to select a string of character information in a displayed window and store the selected string; and performing a second operation to extract a telephone number from the stored string and to display the extracted telephone number in a first window. Furthermore, Bayless fails to disclose or suggest a telephone call dialing method including performing a third operation to dial a call, based on a telephone number extracted according to the second operation. Therefore, claim 5 is not anticipated by Bayless.

Claim 23 is directed to a computer-readable recording medium. Claim 23 recites features similar to claim 5. Therefore, claim 23 is not anticipated by Bayless based on a rationale analogous to that set forth above for claim 5. Consequently, claims 6-9 are not anticipated by Bayless at least by virtue of their dependency.

C. Claims 11, 13 and 15-21

Claim 11 is directed to an information terminal having a unique combination of features including, *inter alia*, display application means and selection means. As an initial matter, Applicant amends claim 5 to further clarify that the display application means can execute a first application used to display a first window for assistance in controlling a call dialing operation; and that the selection means can select a string of character information in a second window displayed by the operating system, wherein the second window is associated with a second application unrelated to the call dialing operation.

It is respectfully submitted that Bayless fails to disclose or suggest any selection means that can select a string of character information in a second window displayed by an operating system, wherein the second window is associated with a second application unrelated to a call dialing operation. Therefore, claim 11 is not anticipated by Bayless. Consequently, claims 13 and 15-21 are not anticipated by Bayless at least by virtue of their dependency.

IV. Claim Rejections – 35 U.S.C. § 103(a)

Claims 4 and 14 stand rejected under § 103(a) as allegedly being unpatentable over Bayless in view of Detering.

The Examiner acknowledges that Bayless fails to disclose or suggest the feature of deleting information except for that relevant to numerals from the selected string of character information, such that the telephone number to be dialed is extracted from the resulting remainder (Office Action: pages 11-12). The Examiner relies on Detering to make up for this acknowledged deficiency of Bayless (*Id.*).

Detering, however, fails to make up for the deficiencies of Bayless set forth above for claims 1 and 10, from which claims 4 and 14 respectively depend. For example, like Bayless, Detering fails to teach or suggest a telephone call dialing method including performing a first operation to select a string of character information in a displayed window and store the selected string; and performing a second operation to extract a telephone number from the stored string and to display the extracted telephone number in a first window. Furthermore, Detering fails to disclose or suggest a telephone call dialing method including performing a third operation to dial a call, based on a telephone number extracted according to the second operation. Therefore, claims 4 and 14 are patentable over the proposed combination of Bayless and Detering.

V. New Claims 24-47

Applicant adds new claims 24-47, which recite disclosed but previously unclaimed features of the present invention, to obtain an expanded scope of protection. It is respectfully submitted that each of new claims 24-47 are patentable at least by virtue of its dependency.

DRAFT AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/238,502
Attorney Docket No. Q52863

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Billy Carter Raulerson
Registration No. 52,156

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: December 10, 2004